

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, in light of the following discussion, is respectfully requested.

This Request for Reconsideration is in response to the Office Action mailed on July 7, 2005. Claims 2-17 are pending in this Application and stand rejected.

In the outstanding Office Action, Claims 2-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art (hereinafter "AAPA") in view of Sekikawa et al. (JP 10042383A, hereinafter "Sekikawa") and further in view of Robb (U.S. Patent No. 6,177,950) or Maruyama et al. (U.S. Patent No. 6,760,074, hereinafter "Maruyama"). Applicants note that although only Claims 2-4 were formally rejected by the cited combination, Applicants have assumed that the rejection based on the cited combination applied to Claims 5-17 as well in view of the application of the cited references to features recited in those claims.

Applicants thank Examiner George Eng for the courtesy of an interview extended to Applicants' representative on August 30, 2005. During the interview, Arguments as hereinafter developed were presented. No agreement with respect to the claims was reached during the interview. Examiner Eng noted in the interview summary (PTOL-413) that "Examiner's explained the position on the outstanding office action and explained that the motivation of combining the references for rejecting the claimed limitations can be found in the references, for example Maruyama (col. 14 line 41 through col. 15 line 22). However, Applicant's representative disagreed. A further consideration is required upon a response if filed."

As explained during the interview, Applicants respectfully submit that AAPA, Sekikawa, Robb, and Maruyama, neither individually nor in any combination, support a

*prima facie* case of obviousness of the invention recited in independent Claims 1 and 9. This is so because there is no motivation to combine the references.

Recapitulating, Claim 2 recites, among other features, a first component holding unit to hold an image pickup device on a main surface of a board such that a central substantial portion of a surface of the image pickup device is held in direct contact to the main surface of the board. Claim 9 recites that the first component holding unit is configured to hold a substantial portion of a bottom surface of the image pickup device in direct contact to the flat portion of the main surface.

In the outstanding rejection, (1) it was acknowledged that “neither AAPA nor Sekikawa specifically teaches the first component holding unit being configured to hold a substantial portion of a surface of the image pickup device in direct contact to said main surface;”<sup>1</sup> and (2) Robb and Maruyama were cited for purportedly disclosing the acknowledged features missing from the combination of AAPA and Sekikawa because it would be obvious to mount “a camera with a main board in a manner that a central substantial portion of a surface of the camera is in direct contact to a main surface of the main board”<sup>2</sup> in order to “provide a portable device, which can easily implement function extension without impairing portability”<sup>3</sup> as purportedly taught and disclosed by Robb and Maruyama. As noted above, during the personal interview, Examiner Eng explained that the motivation to combine was substantiated by the subject matter disclosed in Maruyama from col. 14, line 41 to col. 15, line 22. However, even when considering this cited portion of

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<sup>1</sup> Outstanding Office Action, page 4, lines 1-5.

<sup>2</sup> *Id.*, lines 6-9.

<sup>3</sup> *Id.*, lines 16 and 17.

Maruyama, there is insufficient evidence in the record for a motivation to modify AAPA and Sekikawa by the teaching of either Robb or Maruyama for the following reasons.<sup>4</sup>

Maruyama relates to a cabinet for a portable computer that can “easily implement function extension without impairing portability.”<sup>5</sup> The cabinet disclosed comprises a top case 1, a bottom case 10, and a middle case 16. See, for example, FIG. 2 of Maruyama. As shown in FIGS. 5-10, when extension of functionality is desired, extension units 1000, 1010, 1020, 1030, and 1040 may be stacked between the top and bottom cases 1 and 10 by use of modified middle cases 16 of different thicknesses. Added extension 1000 may comprise a hard disk device 24, an optical disk unit 25, a flash memory 26, an antenna 27 for IC card and/or a card slot 28.<sup>6</sup> The added extension unit 1010 comprises an optical disk unit 25 and a magnetic disk unit 29.<sup>7</sup> Extension unit 1020, 1030, and 1040 are simply referred to as a plurality of extension units, but, the functions to be extended in general were defined.<sup>8</sup>

As clearly disclosed in Maruyama, there is no relationship between the placement of CCD camera 17 on main board 20 and the implementation of function extensions. In Maruyama, as just explained, when a function extension is desired, one or more extension

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<sup>4</sup> See MPEP 2143.01 stating “[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,” (citations omitted). See also MPEP 2144.08 III stating that “[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings.”

<sup>5</sup> Maruyama, col. 2, lines 5 and 6.

<sup>6</sup> *Id.*, col. 8, line 66 – col. 9, line 9.

<sup>7</sup> *Id.*, col. 11, lines 31-35.

<sup>8</sup> “An embodiment of the function extension unit is a disk unit for supplementing a shortage of capacity of a built-in memory. Preferably, the disk unit includes a hard disk unit, an optical disk unit, an optomagnetic disk unit or a magnetic disk such as a floppy disk. Another embodiment of the function extension unit includes a public line connection medium such as a wireless or wired communication line modem and a short-distance wireless connection medium such as a contactless IC card data transmitting/receiving unit or a short-distance wireless network connection transmitting/receiving unit. Still another embodiment of the function extension unit includes an extension board for improving the fundamental performance of the portable computer (such as a graphic accelerator) and a large-capacity battery for prolonging usable time of the portable computer.” *Id.*, col. 2, lines 27-43.

units are added between top and bottom cases 1 and 10 with the requirement that a thicker middle case 16 be provided. As such, Applicants respectfully submit that one of ordinary skill in the art, considering the teachings of Maruyama, would not be motivated to place “a camera with a main board in a manner that a central substantial portion of a surface of the camera in direct contact to a main surface of the main board” in order to “provide a portable device, which can easily implement function extension without impairing portability,” as alleged by the Office.

In addition, the portion of Maruyama cited during the interview does not remedy the above-summarized problem with the asserted motivation to combine. In the cited portion, Maruyama teaches that “in the portable computer according to the present embodiment, the thickness t is increased when the function of the portable computer is extended.”<sup>9</sup> In other words, as function extensions are added, portability is decreased and not maintained as proposed by the Office.

Robb relates to a personal communication device that includes a camera 2 mounted on a rotating printed circuit board 91. Applicants further note that Robb is silent as to any need to extend functionality while maintaining portability, thus also failing to provide the needed substantial evidence in support of a motivation to combine.

While either Maruyama or Robb may provide a reason for holding an image pickup device in direct contact with a printed circuit board in the portable computer or in the multifunctional portable telephone respectively disclosed, Both references fail to suggest why a person of ordinary skill in the art would be motivated to incorporate such a feature in the portable phone resulting from the combination of AAPA and Sekikawa.

Therefore, none of the cited references provides the motivation to perform the proposed modification of the device resulting from the combination of AAPA and Sekikawa.

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<sup>9</sup> *Id.*, col. 14, lines 41-46.

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In other words, an attempt to bring in the isolated teachings of either Maruyama or Robb into the combined device of AAPA and Sekikawa would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.<sup>10</sup> While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.<sup>11</sup> In this case, the record fails to support the proposed modification of the AAPA and Sekikawa device.

The U.S. Court of Appeals for the Federal Circuit recently vacated a rejection under 35 U.S.C. § 103(a) based on similar grounds.<sup>12</sup> In vacating a rejection, the Court stated:

The record reflects that the examiner and the Board have managed to find motivation for substituting one type of memory for another *without providing a citation of any relevant, identifiable source of information justifying such substitution*. The statements made by the Examiner, upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans. At least under the MPEP then in effect, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on "subjective belief and unknown authority." *Lee*, 277 F.3d at 1344. Under such circumstances, with respect to core factual findings, "the Board **must point to some concrete evidence in the record in support**" of them, rather than relying on its assessment of what is "well recognized" or what a skilled artisan would be "well aware." (emphasis added)

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<sup>10</sup> See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.").

<sup>11</sup> In re Lee, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

<sup>12</sup> In re Beasley, 2004 U.S. App. LEXIS 25055 (Fed. Cir. December 2004).

The Office is respectfully reminded that the position that several devices can be modified to arrive at the claimed invention is insufficient to establish a *prima facie* case of obviousness.<sup>13</sup>

Based at least on the foregoing discussion, Applicants respectfully submit that AAPA, Sekikawa, Maruyama, and Robb, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in Claims 2 and 9 because there is no motivation to combine the cited references. In addition, Claims 3-8 and 10-17, which depend directly from either Claim 2 or Claim 9, are also believed to patently distinguish from the combination of AAPA, Sekikawa, Maruyama, and Robb. Therefore, Applicants respectfully request that the obviousness rejection of Claims 2-17 be withdrawn.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 2-17 is earnestly solicited.

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<sup>13</sup>See MPEP 2143.01 stating that the “fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness”; see also same section stating “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,’” (citation omitted).

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Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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